

12/17/2004 17:55 FAX 18587205125

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Dated: 12/17/04

Signature: 

(Grace Yu)

Docket No : 220002065920
(PATENT)

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Patent Application of:
David EISENBERG et al.

Application No.: 09/712,363

Filed: November 13, 2000

Art Unit: 1637

For: DETERMINING FUNCTIONS AND
INTERACTIONS OF PROTEINS BY
COMPARATIVE ANALYSIS

Examiner: T. Strzelecka

COMMUNICATION AFTER ALLOWANCE

MS Issue Fee
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Dear Sir:

During a conversation with the Examiner on September 7, 2004 regarding the above-identified application, Applicants were asked to enclose a copy of the Examination Report issued April 6, 2004 from the Japanese Patent Office for the corresponding Japanese application (Japanese Patent Application No. 2000-596510) with the response to the next Action from the USPTO.

The subsequent action from the USPTO was the September 17, 2004 Notice of Allowance and Fee(s) Due. Accordingly, enclosed herewith is a copy of the English translation of the Examination Report (Notification of Reason(s) for Refusal) issued from the Japanese Patent Office on April 6, 2004 for Japanese Application No. 2000-596510.

sd-235939

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In the unlikely event that the transmittal letter is separated from this document and the Patent Office determines that an extension and/or other relief is required, Applicant : petition for any required relief including extensions of time and authorize the Assistant Commissioner to charge the cost of such petitions and/or other fees due in connection with the filing of this document to Deposit Account No. 03-1952 referencing docket no. 220002065920. However, the Commissioner is not authorized to charge the cost of the issue fee to the Deposit Account.

Dated: December 17, 2004

Respectfully submitted,

By Karen R. Zachow
Karen R. Zachow, Ph.D.
Registration No.: 46,332
MORRISON & FOERSTER LLP
3811 Valley Centre Drive, Suite 500
San Diego, California 92130
(858) 720-5191

sd-235939



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Dispatch Number: 128112

Dispatch Date: April 6, 2004

NOTIFICATION OF REASON(S) FOR REFUSAL

Patent Application Number	2000-596510
Drafting Date	March 31, 2004
Examiner of JPO	Eiji Takahori 9281 4B03
Representative (Patent Agent)	Sakio Oba et al.
Applied Provision	Patent Law Section 29 main paragraph and (2), and Section 37

This application should be refused for the reasons mentioned below. If the applicant has any argument against the reasons, such argument should be submitted within three months from the date on which this Notification was dispatched (mailed).

REASON(S)

1. The inventions in the claims described below of the subject application should not be granted a patent since the inventions in the claims described below do not comply with the requirements under the main paragraph of Patent Law Section 29.

Note

The invention in claim 1 cannot be perceived as utilizing a law of nature because this claim does not state explicitly that the hardware resources are utilized in order to realize the invention (except in cases where the claim states explicitly that the invention in the claim is realized by utilizing hardware resources such as computer). Likewise, the inventions in claims 27 and 76 cannot be perceived as utilizing a law of nature.

2. The inventions in the claims described below of the subject application should not be granted a patent under the provision of Patent Law Section 29(2) since it could have easily been made by persons who have common knowledge in the technical field to which the inventions pertain, on the basis of the invention described in the publication listed below which were distributed or made available to the public through electric telecommunication line in Japan or foreign

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countries prior to the filing date of the subject application.

Note (The list of cited documents, etc. is shown below.)

- Claims 1 to 46, 76 to 77
- Cited document, etc. 1
- Remarks

Cited document 1 states that the amino acid sequence of the N terminal and C terminal of yeast topoisomerase II show homologies with the amino acid sequence of the bacterial gyrase B and the bacterial gyrase A, respectively. The cited document also states that although the two enzymes differ in both structure and activity, there are evolutionary and structural relationship between the two enzymes. Therefore, it is perceived that for the purpose of identifying functionally-linked polypeptides from among non-homologous polypeptides, comparing the amino acid sequences of non-homologous polypeptides with the amino acid sequence of a protein contained in a database, extracting two or more polypeptides having partial homology with the amino acid sequence of a protein, and identifying the two or more polypeptides as being functionally-linked can be easily made by a person skilled in the art.

3. The subject application does not comply with the requirements under Patent Law Section 37 in regard to the following point.

Note

If the invention in claim 1 is regarded as a specified invention, the inventions in claims 47 to 75 do not fall within any of the relationships provided in Items of Section 37 of the Patent Law with the invention in claim 1. Further, the subject application does not satisfy the requirements under Patent Law Section 37 even if any of the claims other than claim 1 is regarded as a specified invention.

Since the subject application does not satisfy the requirements of the Patent Law Section 37, the inventions except those in claims 1 to 46 and 76 to 77 have not been examined under the requirements stipulated by the provisions other than Section 37.

For the inventions in claims other than those specified in this notification of reason(s) for refusal, no reason for refusal is found at present. If any reason(s) for refusal is found later, it will be notified.

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When an amendment is made, it should be noted that the addition of new matter is not allowable. Furthermore, it is preferable that the points at the specification or drawings as filed on which the amendment is based should be specified in a written argument.

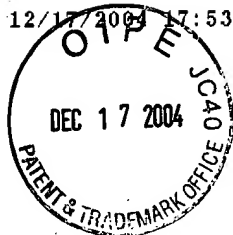
The list of cited documents, etc.

1. Science, Vol. 233, No. 4764 (1986) pp. 647-649
- 2.

Record of the result of prior art search

- Technical field(s) to be searched
 - BIOSIS/WPI (DIALOG)
 - PubMed
 - CA (STN)
- Prior art document(s)
 - Proc. Natl. Acad. Sci. USA., Vol. 96, No. 8 (1999. Apr.) pp. 4285-4288
 - Science, Vol. 285, No. 5428 (1999. Jul.) pp. 751-753
 - Nature, Vol. 402, No. 6757 (1999. Nov.) pp. 83-86
 - Nature, Vol. 402, No. 6757 (1999. Nov.) pp. 86-90
 - Proc. Natl. Acad. Sci. USA., Vol. 95, No. 25 (1998) pp. 14863-14868
 - Science, Vol. 278, No. 5338 (1997) pp. 631-637

This record is not a component(s) of the reason(s) for refusal.

**MORRISON & FOERSTER LLP**

Attorneys at Law

3811 Valley Centre Drive, Suite 500

San Diego, California 92130-2332

Telephone: (858) 720-5100

Facsimile: (858) 720-5125

To: U.S. Patent and Trademark Office
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Facsimile: (703)746-0000
Telephone: (703) 305-3283

From: Karen R. Zachow, Ph.D. – Reg. No. 46,332**Date: December 17, 2004**

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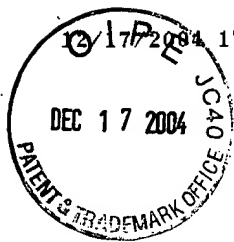
Comments:

ATTORNEY DOCKET: 220002065920
GROUP ART UNIT: 1637
EXAMINER: T. Strzelecka
SERIAL NO.: 09/712,363
FILING DATE: November 13, 2000
INVENTOR(S): David EISENBERG et al.
TITLE: DETERMINING THE FUNCTIONS AND INTERACTIONS OF PROTEINS BY COMPARATIVE ANALYSIS

Papers Attached:

1. Transmittal (1 page)
2. Form PTOL-85, Part B – Fee(s) Transmittal (1 page + duplicate for fee processing)
3. Revocation of Power of Attorney with New Power of Attorney and Change of Correspondence Address (1 page)
4. Statement Under 37 CFR 3.73(b) (1 page)
5. Communication After Allowance (2 pages)
6. Copy of Notification of Reason(s) for Refusal (3 pages)

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GRACE YU AT (858) 720-7972 AS SOON AS POSSIBLE.**



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PTO/SB/21 (09-04)

Approved for use through 07/31/2006. OMB 0851-0031

U.S. Patent and Trademark Office: U.S. DEPARTMENT OF COMMERCE

Under the Paperwork Reduction Act of 1995, no persons are required to respond to a collection of information unless it displays a valid OMB control number.

TRANSMITTAL FORM (to be used for all correspondence after initial filing)	Application Number	09/712,363	
	Filing Date	November 13, 2000	
	First Named Inventor	David EISENBERG	
	Art Unit	1637	
	Examiner Name	T. Strzelecka	
Total Number of Pages in This Submission	11	Attorney Docket Number	220002065920

ENCLOSURES (Check all that apply)		
<input type="checkbox"/> Fee Transmittal Form <input type="checkbox"/> Fee Attached <input type="checkbox"/> Amendment/Reply <input type="checkbox"/> After Final <input type="checkbox"/> Affidavits/declaration(s) <input type="checkbox"/> Extension of Time Request <input type="checkbox"/> Express Abandonment Request <input type="checkbox"/> Information Disclosure Statement <input type="checkbox"/> Certified Copy of Priority Document(s) <input type="checkbox"/> Reply to Missing Parts/Incomplete Application <input type="checkbox"/> Reply to Missing Parts under 37 CFR 1.52 or 1.53	<input type="checkbox"/> Drawing(s) <input type="checkbox"/> Licensing-related Papers <input type="checkbox"/> Petition <input type="checkbox"/> Petition to Convert to a Provisional Application <input checked="" type="checkbox"/> Power of Attorney, Revocation Change of Correspondence Address (1 page) <input type="checkbox"/> Terminal Disclaimer <input type="checkbox"/> Request for Refund <input type="checkbox"/> CD, Number of CD(s) _____ <input type="checkbox"/> Landscape Table on CD	<input checked="" type="checkbox"/> After Allowance Communication to TC (2 pages) <input type="checkbox"/> Appeal Communication to Board of Appeals and Interferences <input type="checkbox"/> Appeal Communication to TC (Appeal Notice, Brief, Reply Brief) <input type="checkbox"/> Proprietary Information <input type="checkbox"/> Status Letter <input checked="" type="checkbox"/> Other Enclosure(s) (please identify below): PTOL-88, Part B - Fee(s) Transmittal (1 page + duplicate for fee processing) Statement Under 37 C.F.R. 3.73(b) (1 page) Copy of Notification of Reason(s) for Refusal (3 pages) Facsimile coversheet (page)
Remarks Customer No.25225		

SIGNATURE OF APPLICANT, ATTORNEY, OR AGENT			
Firm Name	MORRISON & FOERSTER LLP		
Signature			
Printed name	Karen R. Zachow, Ph.D.		
Date	December 17, 2004	Reg. No.	46,332

I hereby certify that this correspondence is being transmitted to the U.S. Patent and Trademark Office at (703) 748-4000, on the date shown below.

Dated: December 17, 2004

Signature: (Grace Yu)

sd-235918